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10/809,278	03/25/2004	Naoki Yamane	9683/174	6036

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EXAMINER

IWUCHUKWU, EMEKA DERRICK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,278	YAMANE ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/22/06.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Art Unit Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 05/22/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Amendment

3. This Office Action is in response to the amendment filed on 04/03/2006.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 9-14** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 9, the limitation "the control unit further operable to limit access by the second application so as to exclude access by the second application to an area other than the are

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assigned to the second application” constitutes subject matter that was not described in the original specification.

The limitation “to exclude access by the second application” is not mentioned in the original disclosure. Applicant has not pointed out where in the original disclosure support can be found for the newly added limitations.

Claims 10-14 are dependent from claim 9 and include the same issues explained above. Therefore, they are rejected for the same reasons explained above.

For examination on the merits the claims shall be interpreted as best understood.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 14** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "via the network" in Line 2. There is insufficient antecedent basis for this limitation in the claim. The Office shall interpret the claim to read “via a network”.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 9-12,14,15,27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson Jr. (*hereinafter Johnson*) in view of U.S. Patent No. 6,598,076 to Chang.

With respect to claims 9,15,27-32, the Examiner notes that, the language used by the Applicant merely suggests or makes optional those features described as “operable”; such language does not require steps to be performed or limit the claim to a particular structure see MPEP 2114.

Regarding claim 9, Johnson teaches a communication terminal operational with at least two applications, each of the at least two applications operable to provide a user interface, the communication terminal comprising: a communication unit operable to transmit and receive data to and from a server (Fig 14, paragraphs 4,14,16); a storage (630, Fig 14); and a control unit coupled with the communication unit and the storage, the control unit operable to control the at least two applications (620, Fig 14), wherein the control unit is further operable to execute a first application operable to identify a second application configured to process data received by the communication unit (paragraphs 96-98,106-112), wherein the first application is further executable to identify the second application on the basis of an attribute of the data, and to store

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the data in a data reception area of the storage, the data reception area being assigned to the second application (paragraphs 96-98,106-112); and the control unit further operable to store data for transmission to a transmission data area of the storage, and to execute the first application to transmit the data via the communication unit (paragraphs 45,106-112). Johnson fails to expressly disclose the control unit further operable to provide the data to the second application in response to a request from the second application; the control unit further operable to limit access by the second application so as to exclude access by the second application to an area other than the area assigned to the second application.

In the same field of endeavor, Chang teaches a similar communication terminal comprising a control unit operable to provide the data to the second application in response to a request from the second application and also operable to limit access by the second application so as to exclude access by the second application to an area other than the area assigned to the second application (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a control unit operable to provide the data to the second application in response to a request from the second application and also operable to limit access by the second application so as to exclude access by the second application to an area other than the area assigned to the second application for the advantage of having a more secure terminal.

With respect to claim 10, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claim 10, Johnson in view of Chang teaches the communication terminal according to claim 9, wherein the first application is adapted to communicate with the server (paragraphs 96-98,106-112); and the second application is not adapted to communicate with the server (Chang, Col 1 Lines 28-44).

Regarding claim 11, Johnson in view of Chang teaches the communication terminal according to claim 9, wherein: the data is email (paragraphs 44,45) and the first and the second applications each provide a user with a user interface for reading and writing email (Chang, Col 1 Lines 28-44).

Regarding claim 12, Johnson in view of Chang teaches the communication terminal according to claim 9, wherein: the storage is removable storage unit detachably coupled with the communication terminal (paragraph 94); and an identifier of the second application is stored in the storage in accordance with the data (paragraph 98).

Regarding claim 14, Johnson in view of Chang teaches the communication terminal according to claim 9, further comprising means for installing a program for executing the second application via a network (612,705, Fig 14).

Regarding claim 15, Johnson teaches a method of executing at least two applications with a communication terminal, the method comprising: providing a first application operable on a communication terminal to generate an email message, to transmit an email message to an email server, to receive an email message from said email server, or to open an email message (paragraph 39); providing a second application on said communication terminal; receiving an email message from said email server with said first application, wherein only said first application is operable to communicate with said email server (paragraphs 96-98,106-112);

determining with said first application if said email message is compatible with said first application or second application (paragraphs 96-98,106-112); storing data related to said email message in a predetermined reception box folder when said email message is compatible with said first application (paragraphs 96-98,106-112) and storing data related to said email message in a folder designated with said email message when said email message is compatible with said second application. Johnson fails to expressly disclose said second application is executable to generate an email message or to open an email message.

In the same field of endeavor, Chang teaches a similar method comprising providing a second application operable on a communication terminal, said second application executable to generate an email message or to open an email message (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a second application operable on a communication terminal, said second application executable to generate an email message or to open an email message so that Excel or Adobe attachments can be sent via email as taught by Chang (Col 1 Lines 28-44).

Regarding claims 27&28, Johnson teaches a communication terminal operational with at least two applications, each of the at least two applications operable to provide a user interface, the communication terminal comprising: a first email application operable in a mobile communication terminal to generate or open email messages (paragraphs 39,44,45); wherein only said first email application is enabled to communicate with an email server to transmit and receive email messages (paragraphs 96-98,106-112). Johnson fails to expressly disclose the limitations associated with the second application.

In the same field of endeavor, Chang teaches a similar terminal comprising a second email application downloadable to said mobile communication terminal, said second email application also operable in said mobile communication terminal to generate or open email messages (Col 1 Lines 28-44); and wherein said second email application is configured to enable said first email application to transmit and receive email messages that are otherwise processed only with said second email application (Col 1 Lines 28-44) and said first email application is operable to receive an email message and determine if said email message is compatible with said first email application or said second email application (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the second email applications disclosed functionalities so that a program like Excel or Adobe Acrobat could create or open email attachments as taught by Chang (Col 1 Lines 28-44).

Regarding claim 29, Johnson in view of Chang teaches the communication terminal of claim 27, wherein said first email application is operable to receive a first category of email messages that are storable in association with a predetermined reception folder that is accessible with said first email application, said first email application is further operable to receive a second category of email messages that are storable in association with a folder identified with a received email message, wherein said second category of email messages are storable for access by said second email application (paragraphs 96-98,106-112).

Regarding claim 30, Johnson in view of Chang teaches the communication terminal of claim 27, wherein said second email application is operable to generate an email message for transmission, said second email application further operable to store said email message

generated for transmission in association with a transmission folder that is accessible with said first email application, wherein said first email application is operable to transmit for receipt by said email server any email message associated with said transmission folder (Chang, Col 1 Lines 28-44).

Regarding claim 31, Johnson in view of Chang teaches the communication terminal of claim 27, wherein said second email application is operable to enable said first email application to generate a folder, said first email application operable to generate said folder and a corresponding identifier in a folder name table, wherein said first email application is operable to store data associated with a received email message in said folder based on said identifier being included in said received email message (Chang, Col 1 Lines 28-44).

Regarding claim 32, Johnson in view of Chang teaches the communication terminal of claim 27, wherein said first email application is operable to generate or open a first type of email message, and said second email application is operable to generate or open a second type of email message that includes an identifier not included in said first type of email message (Chang, Col 1 Lines 28-44).

Regarding claim 33, Johnson in view of Chang teaches the communication terminal of claim 32, wherein said identifier comprises at least one of a character mail identifier or a character identifier (*.pdf, Chang, Col 1 Lines 28-44).

11. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson Jr. (*hereinafter Johnson*) in view of U.S. Patent No. 6,598,076 to Chang, further in view of U.S. Patent Publication 2002/0143885 to Ross Jr. (*hereinafter Ross*).

Johnson in view of Chang teaches the communication terminal according to claim 9. The combination fails to expressly disclose the second application is a program generated with a Java programming language.

In the same field of endeavor, Ross teaches a similar terminal wherein the second application is a program generated with a Java programming language (paragraph 125).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an application generated with Java programming language as a design choice as taught by Ross (paragraph 125).

12. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson Jr. (*hereinafter Johnson*) in view of U.S. Patent No. 6,598,076 to Chang, further in view of U.S. Patent Publication 2006/0004922 A1 to Lahti et al. (*Lahti*).

With respect to claim 16, Johnson in view of Chang teaches the method of claim 15. The combination fails to expressly disclose the step of reading an identifier included in a header of said email message to determine if said first application or said second application is indicated.

In the same field of endeavor, Lahti teaches a similar method comprising the step of reading an identifier included in a header of said email message to determine if said first application or said second application is indicated (paragraph 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of reading an identifier included in a header of said email message to determine the indicated application so that the email can be routed to the proper application.

With respect to claim 17, Johnson in view of Chang further in view of Lahti teaches the method of claim 16, wherein storing data related to said email message in a folder designated in said email message comprises the steps of checking a table stored in said communication terminal for said identifier and a corresponding folder name, and storing said data related to said email message in said folder that is associated with said identifier and is accessible by said second application (Johnson, paragraphs 96-98,106-112).

With respect to claim 18, Johnson in view of Chang further in view of Lahti teaches the method of claim 17, further comprising the step of executing said second application to access

said folder based on said identifier (Chang, Col 1 Lines 28-44) and to display a listing that includes an email title, an email reception date (Johnson, Fig 1). The combination fails to expressly disclose, an email reception time of said email message that is retrieved from said folder. However the Examiner takes Official Notice that displaying an email reception time of said email message that is retrieved from a folder was well known in the art at the time the invention was made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the email reception time of the email message so that a more exact time or email arrival would be known.

With respect to claim 19, Johnson in view of Chang further in view of Lahti teaches the method of claim 18, further comprising the steps of said second application obtaining a message identification associated with said listing and extracting said email message from a stored location for display based on said message identification (Chang, Col 1 Lines 28-44).

With respect to claim 20, Johnson in view of Chang further in view of Lahti teaches the method of claim 15, further comprising the step of said second application instructing said first application to generate said folder and a folder table, said application executable to display data associated with said email messages stored in said folder as a function of said folder table (Chang, Col 1 Lines 28-44).

13. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson Jr. (*hereinafter Johnson*) in view of U.S. Patent No. 6,598,076 to Chang, further in view of U.S. Patent Publication 2003/0120496 A1 to Alfred et al. (*hereinafter Alfred*).

With respect to claim 21, Johnson teaches a method of executing at least two application with a communication terminal, the method comprising: providing a first application executable on a communication terminal to generate an email message, to transmit an email message to an email server (paragraphs 44,45) to receive an email message from said email server (paragraph 39), and to open an email message; providing a second application executable on said communication terminal to generate an email message, to open an email message, and to open an email message, and to cooperatively operate with said first application, wherein only said first application is operable to communicate with said email server; generating an email message with said second application and with said second application enabling said first application to transmit said email message. Johnson fails to expressly disclose generating an email message with the second application.

In the same field of endeavor, Chang teaches a similar method comprising: providing a second application executable on said communication terminal to generate an email message, to open an email message, and to cooperatively operate with a first email application, wherein only said first application is operable to communicate with said email server; and with said second application enabling said first application to transmit said email message (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the generating and opening email capabilities for the advantage of creating email attachments in Excel or Word as taught by Chang (Col 1 Lines 28-44). Johnson in view of Chang fails to expressly disclose generating an email message with said second application.

In the same field of endeavor, Alfred teaches a similar method including a second application generating an email message (paragraph 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate an email message with the second application to generate attachments using Excel or Word.

With respect to claim 22, Johnson in view of Chang further in view of Alfred teaches the method of claim 21, wherein the step of generating an email message with said second application comprises the further steps of storing said generated email message in association with a transmission folder used by said first application to transmit outgoing email messages, and executing said first application to transmit said email message (Chang, Col 1 Lines 28-44).

With respect to claim 23, Johnson in view of Chang, further in view of Alfred teaches the method of claim 22, wherein the step of executing said first application comprises the further steps of said first application detecting association of said email message with said transmission folder, and said first application retrieving and transmitting said email message for receipt by said email server (Johnson, paragraphs 39,44,45,96-98).

With respect to claims 24-26, Johnson in view of Chang, further in view of Alfred teaches the method of claim 21, further comprising the steps of receiving an email message transmitted from said email server with only said first application, and storing said email message for access by said second application only when said email message includes an indication of compatibility with said second application and wherein the step of storing said email message for access by said second application further comprises the step of storing data related to said email message in a folder identified by said email message and wherein said first application is initially installed on said communication terminal and said second application is downloadable to said communication terminal over a network to generate and open a second

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type of email messages that are transmitted and received by only said first application, but are not opened or generated with said first application (Col 1 Lines 28-44).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDI


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